

REMARKS/ARGUMENTS

The indication of allowed claims is acknowledged. Changes have been made in the claims in a sincere attempt to place the case in immediate condition for allowance. Claims 5-7 and 9 have been amended, Claims 8, 12 and 13 have been canceled, and Claims 16-19 have been added. Thus, the claims before the Examiner are Claims 1-7, 9, 10, and 14-19.

Minor changes have been made in Claims 5 and 6, which changes do not detract from the prior allowance.

The rejection under the second paragraph of 35 U.S.C. § 112 is noted. Claims 8, 12 and 13 have been canceled and replaced with new Claims 16-19. None of the claims contain the phrase “working up.” The claims now refer to specific separating steps disclosed in the specification at page 7, lines 7-9, and page 10, lines 33-34. New Claims 18 and 19 are similar to Claims 16 and 17 but depend from Claim 7.

The rejection of Claims 7, 12, and 13 under 35 U.S.C. § 102 as anticipated by Derango et al. is respectfully traversed. The Examiner asserts that the claim (Claim 7) is a product-by-process claim for preparing (meth)acrylic esters comprising at least one urethane group. This is true. The Examiner asserts that the product shown in Derango et al. is within the scope of the claims, therefore constituting an anticipation thereof. Applicants respectfully disagree because Claim 7 specifically calls for reacting various nitrogen-containing materials recited with specificity with a carbonate, which, in turn, is reacted with a (meth)acrylic acid or a saturated alcohol ester of (meth)acrylic acid in the presence of an enzyme to give a (meth)acrylic ester comprising at least one urethane. The nature of the nitrogen-containing products reacted with the carbonate is significantly different from what is shown in Derango et al. The carbamoyloxyethyl methacrylate of the reference (the only (meth)acrylic ester having a urethane group shown) has two hydrogen atoms attached to the nitrogen atom. Using the reaction scheme in pending Claim 6 for reaction of a nitrogen-containing

Application No. 10/536,968
Reply to Office Action of May 22, 2006

compound with a carbonate to form an alcohol having at least one urethane, that nitrogen-containing compound would have to be ammonia (NH_3) to give the reference compound. Pending Claim 7 in contrast lists various nitrogen-containing compounds that are simply unrelated to and are not suggested by ammonia. The reaction products therefore are different, indeed patentably different. The rejection should be withdrawn.

The Examiner is thanked for listing references submitted with an Information Disclosure Statement. The Examiner is asked to acknowledge receipt from the International Bureau of a certified copy of the priority document.

In view of the foregoing revisions and remarks, it is respectfully submitted that the application is in condition for allowance and a USPTO paper to those ends is earnestly solicited. The Examiner is requested to telephone the undersigned if additional changes are required in the case prior to allowance.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon


Charles A. Wendel
Registration No. 24,453

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

NFO:CW\rlc